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Fay Kaplun & Marcin, LLP 150 Broadway, suite 702 New York, NY 10038			BOLES, SAMEH RAAFAT	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MIRKO ROCCI, FABIENNE FISCHER, FRANCO CICOIRA,  
and MARTIN LANGER

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Appeal 2018-005956  
Application 14/320,470  
Technology Center 3700

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Before BRETT C. MARTIN, JILL D. HILL, and PAUL J. KORNICZKY,  
*Administrative Patent Judges.*

KORNICZKY, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE<sup>1</sup>

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>2</sup> appeals from the Examiner’s decision to reject claims 1–7 and 10–13 under 35 U.S.C. § 102(a)(2) as being anticipated by Horan (US 2013/0211459A1, published August 15, 2013).<sup>3</sup> *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

The claims are directed to a metacarpal bone plate. Claim 1, the only independent claim on appeal, is reproduced below with disputed limitations italicized for emphasis:

1. A bone plate sized and shaped for fixation to a metacarpal, comprising:
  - a head extending from a first end to a second end and having first and second fixation element holes extending therethrough along first and second fixation element hole axes, wherein the first hole axis diverges from the second hole axis on a bone facing side of the plate, the head having a first notch on the first end centered on the central longitudinal axis, *the first*

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<sup>1</sup> In this Decision, we refer to (1) the Examiner’s Final Office Action dated June 26, 2017 (“Final Act.”), Advisory Action dated August 23, 2017 (“Adv. Act.”), and Answer dated March 20, 2018 (“Ans.”), and (2) Appellant’s Appeal Brief dated November 6, 2017 (“Appeal Br.”) and Reply Brief dated May 21, 2018 (“Reply Br.”).

<sup>2</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42.

<sup>3</sup> Claims 14–17 are withdrawn, and claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Final Act. 1; Appeal Br. 10–12 (Appeal App.).

*notch formed as a[n] indentation on an outer wall of the bone plate sized and shaped to accommodate a collateral ligament when the plate is fixed to a metacarpal in a desired position; and a shaft extending from the second end of the head to a third end along the central longitudinal axis, the shaft including an elongated fixation element hole elongated in a direction parallel to the central longitudinal axis.*

## DISCUSSION

### *Rejection 1: Claims 1–7 and 10–13 as Anticipated by Horan*

The Examiner finds that Horan discloses all of the limitation of claim 1 including a first notch which forms as an “indentation on an outer wall of the bone plate sized and shaped to accommodate a collateral ligament when the plate is fixed to a metacarpal in a desired position.” Final Act. 4; Adv. Act. 2. The Examiner states that “the notch formed as an indentation on an outer wall of the bone plate of Horan is capable to accommodate a collateral ligament when the plate is fixed to a metacarpal in a desired position.” Final Act. 4; Adv. Act. 2. The Examiner also states that because “the space between two neighboring metacarpal bones are full of ligaments,” Horan’s first notch “would accommodate to a ligament when the notch of the head of the bone plate of Horan extends into the space between two neighboring metacarpal bones.” Reply Br. 5.

Appellant asserts that the rejection is erroneous because Horan’s bone plate “is configured for *pancarpal* arthrodesis.” Appeal Br. 5. According to Appellant, Horan’s “bone plate is placed on a *dorsal* side of the hand/wrist/arm to stabilize the bones of each relative to one another to promote healing in the carpal region by fixation to the radius, at least *two*

carpal bones (radial and ulna) and at least *two* metacarpal bones.” *Id.* (citing Horan ¶¶ 33, 35); *see also* Reply Br. 5. Appellant explains that because Horan’s “distal-most holes 63 are positioned so that fixation elements inserted therein extend into corresponding metacarpal bones 34,” the “notch, or indented space located at the distal end of the distal portion 50 necessarily extends between two consecutive metacarpal bones 34 such that it cannot be configured to accommodate a collateral ligament.” *Id.* at 5–6. Appellant states that, in contrast to Horan, the claimed bone plate “is configured for fixation to a *lateral* side of a metacarpal bone, allowing the collateral ligament to move freely without interference with the bone plate.” *Id.* (citing Spec. ¶ 16). We find Appellant’s argument persuasive.

Horan discloses a pancarpal arthrodesis bone plate 40 which is secured to multiple bones on a dorsal side of the hand and arm, as can be seen in Figs. 2B-2C. We agree with Appellant that collateral ligaments, however, extend on the lateral sides of the metacarpal and carpal bones, and the “metacarpal ligaments extend only at the base of the metacarpal bones and at the distal end of the metacarpal bones, associated with the joints at either end.” Appeal Br. 6; Reply Br. 6. However, as can be seen in Figure 3 of Horan, apertures 63, 64 are configured to be placed over the long portion of the metacarpals and do not appear to accommodate the collateral ligaments of the metacarpal joints. Thus, Horan’s notch is positioned over the space between the two metacarpals. Appellant also argues persuasively that one skilled in the art would understand that “the collateral ligaments are *specific* ligaments positioned on the lateral sides of the metacarpal and carpal bones.” Reply Br. 6. The Examiner must show that Horan’s notch accommodates the claimed *collateral ligament*, not *any* of the many

ligaments in the hand. *See* Ans. 5. The Examiner does not explain how Horan's notch could accommodate collateral ligaments located on the lateral sides of the metacarpal and carpal bones, while still being centered on the central longitudinal axis of the bone plate, and also function as a pancarpal arthrodesis plate as disclosed in Horan, including Figures 2B–2C. The Examiner also has not provided any description of how the plate of Horan can accommodate a collateral ligament when fixed to a metacarpal without altering the plate in some way.

For the above reasons, the rejection of independent claim 1 and claims 2–7 and 10–13 depending from claim 1 is not sustained.

#### CONCLUSION

The Examiner's rejection of claims 1–7 and 10–13 is REVERSED.

#### DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–7, 10–13	102	Horan		1–7, 10–13

REVERSED